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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,234	09/04/1998	IOANNIS MOUITSATSOS	GI5298A	3002

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EXAMINER

LEFFERS JR, GERALD G

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No. 09/148,234	Applicant(s) MOUTSATSOS ET AL.	
Examiner Gerald G Leffers Jr., PhD	Art Unit 1636	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any unexpired patent term adjustment. See 37 CFR 1.704(b).

- ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

- ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
- ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 24-28.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

- ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
- ☐ Other: \_\_\_\_\_

Gerald G Leffers Jr., PhD  
Primary Examiner  
Art Unit: 1636

*Attachment to Advisory Action*

**Continuation of 2. NOTE:** The newly added term "organized" functional bone formation changes the scope of the invention, necessitating a new search of the claimed invention. Also, the proposed amendment raises issues under 35 U.S.C. 1st and 2nd paragraphs. For example, there does not appear to be literal support in the specification for this term, raising the issue of New Matter. The passages cited in applicants' response do not provide support for this term. Nor is the term explicitly defined in the specification such that the skilled artisan would necessarily know what degree of "organization" would satisfy the limitation of "organized, functional bone formation". In addition, the proposed amendment is in fact nonresponsive in that not all of the claims are present as part of a separate section (e.g. claim 28 is present as part of the arguments section) and in that the wrong status identifier is used for claim 28 (i.e. "previously amended" should be "previously presented"). Applicants are referred to <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>, which details the changes made to 37 CFR 1.121 as of 30 June 2003.

**Continuation of 5. does NOT place the application in condition for allowance because:** All of the arguments, including the Declaration submitted under 35 U.S.C. 1.132 by Dr. Gazit, are directed to the proposed amendment. The arguments are moot since the proposed amendment has not been entered.

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**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr., PhD whose telephone number is (571) 272-0772. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gerald G Leffers Jr., PhD  
Primary Examiner  
Art Unit 1636

ggl

  
GERRY LEFFERS  
PRIMARY EXAMINER